UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,865	11/26/2003	Edward P. Szuszczewicz	EPSZ.0010000	6067

34611 7590 12/14/2005	EXAMINER
LAW OFFICE OF DUANE S. KOBAYASHI 1325 MURRAY DOWNS WAY RESTON, VA 20194	RUTLEDGE, AMELIA L

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/721,865	SZUSZCZEWICZ, EDWARD P.
	Examiner	Art Unit	
	Amelia Rutledge	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*26 November 2003*</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>*26 November 2003*</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>*6/7/04-*</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: original application, filed

11/26/2003.

2.   Claims 1-23 are pending. Claims 1 and 16 are independent claims.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4.   **Claims 16-19, 22, and 23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In regard to independent claim 16, the combined limitations of claim 16 are non-statutory as not being tangibly embodied in a manner so as to be executable. The combined limitations of the claim do not require the use of hardware to implement the claimed methods and/or systems. For example, "*A method for editing a graphical image page amongst a collection of a plurality of graphical image pages...*" could be interpreted as a series of mental and/or manual steps, which renders the claimed invention non-statutory, instead being directed toward an abstract idea.

In regard to dependent claims 17-19, 22, and 23, said claims are rejected because they add nothing to render the claimed subject matter statutory.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

6.   Claims 2, 5, 10, and 21 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 5, 10, and 21 contain the trademark/trade name "Microsoft Word". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a word processor and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   **Claims 1-23 rejected under 35 U.S.C. 103(a) as being unpatentable over**

Microsoft Word 2000 (hereinafter "MS Word"), copyright 1983-1999, Microsoft

Corporation, in view of Fisher et al. (hereinafter "Fisher"), U.S. Patent No.

6,771,801, issued August 2004.

9.   For illustrative purposes, screen shots of Microsoft Word 2000, p. 1-15 are cited

to clarify the following claim rejections.

Independent claim 1 cites: *A method for generating a photo album page,*

comprising: opening a photo album page using a word processor; assigning a

background pattern to said photo album page;

MS Word teaches opening a page which can be used as a photo album, i.e., File, New

to create a new document (p. 7). MS Word teaches assigning a background pattern to

a page (p. 2) by selecting Format, Background menu options. MS Word teaches the

use of templates which were used for generating user specified documents such as a

photo album page (p. 4). While MS Word does not explicitly teach generating a photo

album page, Fisher teaches a method of generating a photo album page using a

template and images supplied by a user (Col. 1, l. 48-Col. 2, l. 3). Both Fisher and MS

Word are directed toward using templates to format digital media. It would have been

obvious to one of ordinary skill in the art at the time of the invention to apply Fisher to

MS Word, so that MS Word would have the benefit of a user editable photo album

template that would adjust to the number of images supplied by a user (Fisher, Col. 1, l.

40-45; Col. 1, l. 65-Col. 2, l. 4).

Claim 1 also cites: *selecting a layout configuration for said photo album page,*

said layout configuration defining a number of photos to be included on said photo

album page and a relative position between said group of photos on said photo album

page; and placing a group of photos on said photo album page at locations defined by

said layout configuration.

MS word teaches the creation of a table layout configuration, by selection of menu

options Table, Insert, Table where a number of cells to contain photos, i.e., images, can

be defined and relative position, i.e., AutoFit to contents option can be defined. Photos

from a group, i.e., as in photos selected from file or from Microsoft Clip art, can be

placed in the page at the locations defined within the table (p. 4-6).

Regarding dependent claims 2 and 3, MS Word teaches opening a page, i.e.,

a photo album page using Microsoft Word program components, i.e., File, New to

create a new blank document (p. 7).

Regarding dependent claims 4-7, MS Word teaches selecting a background

pattern using Format, Background menu options for both a selection of JPEG files that

are represented by thumbnail images and a selection of Microsoft Word files that are

represented by thumbnail images (p. 2, "Pattern" and "Picture" tab, p. 6). MS Word

teaches assigning a solid, blend, texture, pattern, theme or mosaic to said photo album

page.

Regarding dependent claims 8-11, MS Word teaches the use of templates, i.e.,

layout configurations that are represented by thumbnail images (p. 4); that includes

placeholders for photo images, and that further defines one or more

relative positions for text entries. For example, the brochure template contains text

boxes where pictures could be inserted, and placeholders for photo images (p. 8-9).

Regarding dependent claims 12-14, MS Word teaches dragging and dropping,

copying, pasting, grouping, and associating images on a page (p. 10-12).

Regarding dependent claim 15, MS Word teaches automatically adjusting

dimensions of a frame border and a photo relative to each other, as in adjusting the

border of a table containing pictures (p. 13, 14). Also see Table menu tab where a

number of cells to contain photos, i.e., images, can be defined and relative position, i.e.,

AutoFit to contents option can be defined

Independent claim 16 cites: *A method for editing a graphical image page*

amongst a collection of a plurality of graphical image pages, comprising: displaying a

first graphical image page from among the plurality of graphical image pages, said first

graphical image page including at least one grouping of graphical image data, wherein

each group of graphical image data can be individually modified; producing a second

graphical image page based on said first graphical image page; displaying said second

graphical image page along with said first graphical image page; receiving first user

input that modifies part of either said first or second graphical image page, wherein said

modification enables the user to contrast said first and second graphical image pages;

and receiving second user input that selects one of said first and second graphical

image pages.

MS Word teaches the use of templates which were used for generating user specified

documents such as a photo album page (p. 4). MS Word teaches that templates can be

created from existing documents, such as a user created table containing graphic

images, compare to *producing a second graphical image page based on said first*

graphical image page. MS Word teaches grouping images, i.e., drawing objects (p. 12),

and that each group can be individually modified, as by the menu options on the

Drawing toolbar. MS Word allows a user to modify both documents and templates and

select pages. MS Word teaches a side by side display of document pages, i.e., menu

options Window, Split.

While MS Word does not explicitly teach editing a graphical image page, Fisher

teaches a method of generating a photo album page using a template and images

supplied by a user (Col. 1, l. 48-Col. 2, l. 3). Both Fisher and MS Word are directed

toward using templates to format digital media. It would have been obvious to one of

ordinary skill in the art at the time of the invention to apply Fisher to MS Word, so that

MS Word would have the benefit of a user editable photo album template that would

adjust to the number of images supplied by a user (Fisher, Col. 1, l. 40-45; Col. 1, l. 65-

Col. 2, l. 4).

Regarding dependent claim 17, While MS Word does not explicitly teach

generating a photo album page, Fisher teaches a method of generating a photo album

page using a template and images supplied by a user (Col. 1, l. 48-Col. 2, l. 3). Both

Fisher and MS Word are directed toward using templates to format digital media. It

would have been obvious to one of ordinary skill in the art at the time of the invention to

apply Fisher to MS Word, so that MS Word would have the benefit of a user editable

photo album template that would adjust to the number of images supplied by a user (Fisher, Col. 1, l. 40-45; Col. 1, l. 65-Col. 2, l. 4).

Regarding dependent claims 18-21, MS Word teaches a grouping of graphical image data on a page including a background pattern and a layout configuration modifiable by a user. MS Word teaches selecting a background pattern using Format, Background menu options for both a selection of JPEG files that are represented by thumbnail images and a selection of Microsoft Word files that are represented by thumbnail images (p. 2, "Pattern" and "Picture" tab, p. 6). MS Word teaches assigning a solid, blend, texture, pattern, theme or mosaic to said photo album page. MS Word teaches grouping images, i.e., drawing objects (p. 12), and that each group can be individually modified.

Regarding dependent claim 22, MS Word teaches deleting a graphical image page, for example, by not saving a document when closing a window.

Regarding dependent claim 23, MS Word teaches a side by side display of document pages, i.e., menu options Window, Split.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia Rutledge whose telephone number is 571-272-7508. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR

WILLIAM BASHORE
PRIMARY EXAMINER
12/9/2005